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23364 7590 04/22/2008 BACON & THOMAS, PLLC 625 SLATERS LANE FOURTH FLOOR ALEXANDRIA, VA 22314				
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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* TOSHIAKI KANEMITSU and KAZUYUKI ODA

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Appeal 2008-1166  
Application 09/638,032  
Technology Center 3700

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Decided: April 22, 2008

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Before WILLIAM F. PATE, III, TERRY J. OWENS, and MICHAEL W.  
O'NEILL, *Administrative Patent Judges*.

O'NEILL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Kanemitsu, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 7-12. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

## SUMMARY OF DECISION

We REVERSE.<sup>1</sup>

### THE INVENTION

The claimed invention is directed to a method of producing a rotary member.

Claims 7 and 8, reproduced below, are representative of the subject matter on appeal.

7. In a method of producing a rotary member made of a metallic plate by which there is formed, at the center of a plate-like metallic blank, a case-like boss which projects in one direction from the lateral side of the blank, said method comprising the steps of: curving a plate-like metallic blank such that said blank is convex in the direction in which a boss is adapted to project, has a resulting arcuate portion, and an outer peripheral edge portion as well; and restraining the outer peripheral edge portion of the curved blank from extending radially outwardly while bending said resulting arcuate portion of the curved metallic blank in the direction opposite to the convex direction using a plurality of molds to gradually reduce the boss, so that the boss is case-like having an annular flat portion, such that the boss and annular flat portion have substantially the same thickness.

8. In a method of producing a rotary member made of a metallic plate by which a plate-like metallic blank is processed such that the blank is provided at the center thereof with a case-like boss

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<sup>1</sup> Our decision will make reference to Appellants' Appeal Brief ("App. Br.," filed Nov. 22, 2006), Reply Brief ("Reply Br.," filed Mar. 26, 2007), and the Examiner's Answer ("Answer," mailed Jan. 25, 2007).

projecting in one direction from one lateral side of the blank, and at the outer periphery thereof with a case-like peripheral wall concentrically projecting in the same direction in which the case-like boss projects, said method comprising the steps of: a first curving step of curving a plate-like metallic blank such that said blank is convex in the direction in which a boss is adapted to project, has a resulting arcuate portion, and an outer peripheral edge portion as well; restraining the outer peripheral edge portion of said curved blank from extending radially outwardly, while bending said resulting arcuate portion of the curved metallic blank in the direction opposite to the convex direction using a plurality of molds to gradually reduce the boss, so that the boss is case-like having an annular flat portion; and a second curving step of pushing, with the case-like boss having the bottom restrained from being deformed, the inner peripheral portion of the annular flat portion in the direction in which said case-like boss projects, so that a case-like peripheral wall is formed, such that the boss, annular flat portion and said case-like peripheral wall have substantially the same thickness.

### THE REJECTION

The following rejection is before us for review:

Claims 7-12 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

## THE ISSUE

The issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 7-12 as failing to comply with the enablement requirement of 35 U.S.C. § 112, first paragraph.

## FINDINGS OF FACT

We find that the following enumerated findings of fact are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. The disclosed invention relates to a method of producing a rotary member made from a metallic plate to be used as an inner wheel of a V-pulley or rotor of an electromagnetic clutch. (Spec. 1:7-10.)
2. The objective of the invention is to provide a method of producing a rotary member with a small press such that the initial thickness is not reduced so much during the course of the production steps. (Spec. 3:14-22.)
3. The method includes two bending operations. This set of operation restrains the blank from being reduced in thickness due to a plastic flow of the blank material. (Spec. 4: 15-23.)
4. At the bending step, the outer peripheral edge portion of the blank is restrained from radially extending outwardly. As such, the blank material flows toward the center of the blank. (Spec. 5:1-6.)

5. At the second curving step, the boss formed at the bending step is restrained from being deformed. This prevents the blank material from moving both inwardly and outwardly. As such, the outer peripheral edge of the blank and boss are restrained resulting in a product having improved dimensional precision. (Spec. 7:6-17.)
6. During each of the bending steps, the outer peripheral edge portion of the blank comes into contact with the inner surface of an annular projection of the punch holder of each lower mold. Accordingly, the outer peripheral edge portion is always restrained from extending radially outwardly. (Spec. 13:1-6.)
7. During the second curving step, the boss is restrained from being deformed because the center projecting portion of the lower mold is moved inside the boss. This prevents the material from flowing both inwardly and outwardly and enables the peripheral wall to be sufficiently thick. (Spec. 14:21 to 15:4.)

## PRINCIPLES OF LAW

The first paragraph of 35 U.S.C. § 112 requires nothing more than objective enablement. “How such a teaching is set forth, either by the use of illustrative examples or by broad terminology, is of no importance.” *In re Marzocchi*, 439 F.2d 220, 223 (CCPA 1971). As such, the test of enablement is whether one reasonably skilled in the art could make and use the claimed invention based on the specification coupled with information known in the art without undue experimentation. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384 (Fed. Cir. 1986), *cert.*

*denied*, 480 U.S. 947 (1987). Accordingly, the test for compliance with the enablement requirement of 35 U.S.C. § 112, first paragraph, is whether one skilled in the art would have to resort to undue experimentation in order to practice the invention as claimed. In considering this issue, we note that Appellants are not required to disclose every parameter encompassed by the claims. *See In re Angstadt*, 537 F.2d 498, 503 (CCPA 1976). And, it is the Examiner's burden to show that one skilled in the art would have to resort to undue experimentation in order to practice the invention as claimed. *See Marzocchi*, 439 F.2d at 224.

#### ANALYSIS

In response to the ground of rejection, the Appellants have pointed to various passages in their Briefs to demonstrate enablement. (App. Br. 5-6 and Reply Br. 3-4.) The Examiner responded with "such passages in no way provide enablement for the flange portion and the boss portion having the same thickness." (Answer 4.) However, the issue is not whether the flange and boss portions are adequately described in the Specification as having the same thickness, but whether one skilled in the art would have to resort to undue experimentation to practice the claimed invention. As such, the burden is on the Examiner to show that to make the claimed portions the same thickness would require undue experimentation on the part of one of ordinary skill in the art. The Examiner just stating that the passages identified by the Appellant do not provide enablement for the claimed portions to have the same thickness does not met the Examiner's burden of showing undue experimentation. As such, we will not sustain the rejection.

### CONCLUSION

We conclude that the Appellants have shown that the Examiner erred in rejecting the claims.

### DECISION

The decision of the Examiner to reject claims 7-12 is reversed.

### REVERSED

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